

**REMARKS**

Applicant respectfully requests reconsideration of the present application in view of the reasons that follow. Claims 1-22 are submitted for reconsideration.

**Claim Rejections under 35 U.S.C. § 103**

Claims 1-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,342,830 ("Want et al."). In response, Applicant respectfully submits that Want et al. does not disclose, teach, or suggest each and every element of claims 1-22 and respectfully traverses the rejection for the reasons set forth below.

Applicant relies on M.P.E.P. § 2143, which states that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must some suggestion or motivation in the prior art to modify the reference. Second, there must be a reasonable expectation of success. Third, the prior art must teach or suggest all the claim limitations.

Claim 1 is directed to a method of annotating an item with electronic data comprising securing a memory tag to the item. The memory tag comprises a memory and a transponder to enable wireless communication with the memory tag. The memory tag has an external dimension D, wherein the memory tag is adapted for wireless communication only with a transceiver located within a distance of 10D of the memory tag.

Similarly, independent claim 7 is directed to an apparatus comprising a memory tag having an external dimension D, wherein the memory tag is adapted for wireless communication only with a transceiver located within a distance of 10D of the memory tag. In addition, independent claims 17, 18, and 19 are directed to an item comprising a memory tag having an external dimension D, wherein the memory tag is adapted for wireless communication only with a transceiver located within a distance of 10D of the memory tag. Also, independent claim 20 is directed to a method for annotating an item with electronic data comprising securing an RFID tag to the item, wherein the RFID tag has an external dimension D and is adapted for wireless communication only with a transceiver located within a distance

of 10D of the RFID tag. Similarly, independent claim 21 is directed to an apparatus for annotating an item with electric data comprising a transceiver and an RFID tag having an external dimension D, wherein the RFID tag and transceiver are adapted for wireless communication therebetween only when the transceiver is located within a distance of 10D of the RFID tag. Lastly, independent claim 22 is directed to an item annotated with electronic data stored on an RFID tag, wherein the RFID tag has an external dimension D, wherein the RFID tag is adapted for wireless communication only with a transceiver located within a distance of 10D of the RFID tag.

In contrast, Want et al. does not disclose, teach, or suggest a memory tag or RFID tag having an external dimension D, wherein the memory tag or RFID tag is adapted for wireless communication only with a transceiver located within a distance of 10D of the memory tag or RFID tag as claimed in independent claims 1, 7 and 17-22. Instead, Want et al. discloses the selective placement of electronic tags to ensure non-overlapping read zones (Column 14, Lines 4-5), the use of shields to limit the readable range of electronic tags (Column 4, Lines 14-15), and selective enablement and disablement of the electronic tags (Column 5, Lines 1-3). In making the rejection, the examiner principally relied on the discussion of non-overlapping readable regions in Column 1, lines 62-66 and Figure 1 of Want et al..

Figure 1 of Want et al. discloses memory tags attached to a document and a three dimensional object that have non-overlapping readable regions (Column 1, Lines 62-66). Want et al. teaches that the non-overlapping readable regions are created by the selective placement of the electronic tags (Column 14, Lines 4-5), the use of shields (Column 4, Lines 14-15), or by selective enablement or disablement of the electronic tags (Column 5, Lines 1-5). However, the techniques disclosed in Want et al. do not teach, disclose or suggest the limitations of independent claims 1, 7 and 17-22. As stated above, independent claims 1, 7 and 17-22 include a memory tag or RFID tag having a dimension D, wherein the memory tag or RFID tag is adapted for wireless communication only with a transceiver located within a distance of 10D of the memory tag or RFID tag. Moreover, the language of independent claims 1, 7 and 17-22 do not require a “non-overlapping readable region” as suggested by the Examiner.

In sum, Want et al. does not disclose, teach or suggest modifying the communication distance of electronic tags by modifying the electronic tag's construction. Nor does Want et al. teach that the communication distance of an electronic tag be proportionally related to the electronic tag's size. Instead, Want et al. uses placement, transmission shields and enablement/disablement to prevent overlapping communication between multiple electronic tags. Thus, Applicant respectfully asserts that one skilled in the art, reading Want et al. would not find a teaching, implicit or otherwise, of the limitations claimed in independent claims 1, 7 and 17-22. Accordingly, Applicant respectfully submits that Want et al. fails to teach each and every element of the independent claims 1, 7 and 17-22 and requests that the rejection be withdrawn.

In addition, claims 2-6, and 8-16 depend from at least one of independent claims 1 or 7 and are therefore allowable for the reasons set forth above. Thus, applicant respectfully requests reconsideration of claims 2-6, and 8-16 and that the rejection be withdrawn.

**Conclusion**

Applicant believes that the present application is now in a condition for allowance. Favorable reconsideration of the application is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date June 30, 2006

By Thomas J. Bilsch Reg. No. 43438

HEWLETT-PACKARD COMPANY

Customer No.: 22879

Telephone: (202) 672-5485

Facsimile: (202) 672-5399

for William T. Ellis  
Registration No. 26,874